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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,495	06/27/2001	Yusuke Monobe	50023-141	8799
20277	7590	05/27/2004	EXAMINER	
MCDERMOTT WILL & EMERY 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			EDWARDS, PATRICK L	
			ART UNIT	PAPER NUMBER
			2621	7

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/891,495

Applicant(s)

MONOBE, YUSUKE

Examiner

Patrick L Edwards

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☒ Claim(s) 1-23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of language and grammar informalities. A few examples of these informalities are provided below in order to assist the applicant by showing the types of errors that exist in the specification.

a) The first sentence of the abstract is grammatically incorrect.

b) The language used in paragraph [0018], which is also used in several of the subsequent claims, is unintelligible as currently written.

c) Paragraph [0022] recites that the "server may be offered as computer". This is another example of the many idiomatic errors in the specification.

d) the word "electronized", which occurs repeatedly in the specification and subsequent claims, is not an actual word in the English language.

The above examples are NOT an exhaustive list of all the errors in the specification. It is recommended that the applicant proofread the entire specification and correct all the existing idiomatic errors.

Appropriate correction is required.

### *Claim Objections*

2. Claims 1-23 are objected to because of the following informalities:

Claims 1-23 are objected to because these claims either contain the word "electronized" or are dependent on a claim which does. "Electronized" is not a known word in the English language.

Claims 1, 4, 12 and 15 are objected to because of the redundant language (i.e. "are managed using management information for management") used in the preamble of the claim.

Claims 11 and 22 are objected to because of the redundant language (i.e. "management information includes...information...corresponding to said management information") of the claims.

Claims 2, 13 and 19 are objected to because of the grammatically incorrect term "should sent".

Claims 3, 14, 20 and 23 are objected to because the first paragraph of the claim (following the preamble) is unintelligible as currently written.

Claim 18 is objected to because the preamble of the claim is unintelligible.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 3, 14, 18-20 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) With regard to claims 3, 14, 20 and 23, these claims are objected in an above paragraph because they are unintelligible as currently written. It follows that all these claims are indefinite in that the claim never clearly identifies what is being judged by the storage place judging means.

b) With regard to claims 18 and 19, the terms "the users" in claim 18 line 4 and "the sharing attribute information" in claim 19 line 3 lack antecedent basis.

#### *Claim Rejections - 35 USC § 101*

5. 35 U.S.C 101 reads as follow:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 18 and 19 are rejected under 35 U.S.C 101 as being directed to non-statutory subject matter. As currently written, these claims recite purely functional descriptive material, which is non-statutory. This problem can be easily remedied by amending the preamble of the claim 18 by replacing the words "a program" with "A computer program, stored on a computer readable medium"

#### *Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-7, 11-20 and 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Schwab (USPN 6,226,412 B1).

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With regard to claim 1, which is representative of claims 16, Schwab discloses image management terminals (col. 1 lines 18-23). The client computers located at remote sites as disclosed in Schwab are analogous to the image management terminals recited in the claim, and the "central server computer" in Schwab functions as the claimed image management server.

Schwab further discloses providing the terminals with switchover control means for sending image data and management information to the image management server (col. 2 lines 4-7). Schwab discloses uploading images and text to the central computer. This 'text' disclosed in Schwab is analogous to the management information recited in the claim. It follows that the 'central computer' disclosed in Schwab is analogous to the image management server recited in the claims. Schwab further discloses sending the image data and management information (text and image information files mentioned at col. 3 line 39) according to instructions from a user (the user corresponds to the "manager" mentioned at col. 4 line 9, who chooses whether to send the information to the central server). The claimed "switchover control means" are components 12-20 shown in Figure 1 of Schwab. They send the information according to user instructions.

Schwab further discloses that the server has switchover image registration means for registering the image data and management information (which is acquired from the terminals) with specific storage means (col. 5 lines 25-32). The process of using the database files to reference the image files disclosed in the Schwab reference is analogous to the claimed process of registering image data and management information.

With regard to claim 2, which is representative of claim 17, Schwab further discloses that the management information stored in the terminal has sharing attribute information which indicates whether or not image data should be sent to the server (col. 4 lines 9-17). Schwab teaches making a determination about whether to list an image on the central server (i.e. share it) or keep it within the local database (i.e. not share it). If the image in Schwab is not shared, then communication with the central database is cut off (col. 4 lines 15-16). Schwab further discloses that a communication connection (col. 6 lines 50-51) between the terminal and server is accessed with a password (col. 6 lines 39-41), which links "the files themselves with the password" via file header information. Consequently, we can conclude that this password information associated with individual images is analogous to the sharing attribute information recited in the claim.

Schwab further discloses sending (or not sending) the image data and management information to the server on the basis of the sharing attribute information (col. 4 lines 9-17).

With regard to claim 3, Schwab discloses that the image management terminal is provided with a means for judging whether the image data selected by the user is stored in the image management server or in the image management terminal, and means for forwarding or executing a control instruction on the basis of the above determination (col. 8 lines 3-7). Schwab discloses retrieving selected item information and associated images from either the local database or the central database. The process of judging whether the image data is stored in either the local or central databases (the terminal or server) is inherent in retrieving the image from either one of the sources. Additionally, a control instruction must be forwarded or executed when one of the images is retrieved from either the local database or the central database. Moreover, as stated at col. 5 lines 28-32 in Schwab, "the storage

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locations of the associated image files managed by the image file server are referenced by the database file server...” Thus, the database file server 30 functions as the claimed “storage place judging means” and communications server 20 functions as the claimed “terminal data control means”.

With regard to claim 11, Schwab discloses that the management information is key word information of image data (col. 5 lines 25-27). Note that claim 11 requires “at least one”, and the keyword information is the one.

With regard to claim 4, Schwab discloses that the image management terminals store image data and management information for the user operating said image management terminal alone to utilize (col. 4 lines 9-15). Schwab’s terminal data control means is the selection screen and mouse, disclosed at col. 9 lines 34-55.

Schwab further discloses that the image management server stores the image data and management information for a plurality of users to share (col. 2 lines 50-52).

Schwab further discloses that the image management terminal has control means for management of both the image data stored in the image management terminals and the image data stored in the image management server (col. 9 lines 19-33). Schwab discloses managing the image data stored in the image management terminals (ie in the “local database” recited in the Schwab reference at col. 9 line 21). Schwab also discloses managing the image data stored in the image management server (ie the “central database” recited in the Schwab reference at col. 9 line 25). Although the Schwab reference doesn’t explicitly state that these processes are being coordinated by a “control means”, it does teach that “operator uses the mouse to effect the display of the selection screens”, and the image data for both the terminal and the server is managed via the selection screen as discussed at col. 9 lines 19-55.

With regard to claim 5, Schwab discloses that the image management terminal distinguishably displays the image data stored in the image management server and the image data stored in the image management terminals (col. 8 lines 3-14). This cited passage from the Schwab reference shows that image data stored in both the image management terminal and the image management server are displayed. Figures 4-6 of the Schwab reference show that these images are distinguishably displayed. The related image text and item information distinguishes these images from one another.

With regards to claim 6 and 7, Schwab discloses displaying image data, but fails to explicitly state that the image data has different background colors or background patterns associated with it. However, different background areas are inherently associated with different images. Consequently, Schwab inherently teaches displaying image data with different colors or different patterns in the background area by not limiting the nature of the images displayed. They may relate to “any product (new or used), service, or person to be listed within the database” (col. 3, lines 29-32).

With regard to claim 12, all of the limitations of the claim were addressed in the above claim 1 arguments.

With regard to claim 13, all of the limitations of the claim were addressed in the above arguments with respect to claim 2.

The claim 14 limitations were discussed above (see the claim 3 arguments).

With regard to claim 15, all of the limitations of the claim were addressed in the above claim 1 arguments.

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With regard to claims 18 and 19, a program which causes the computer to execute the steps of a method is essential if the image processing method disclosed in Schwab is to function. Therefore, a program is inherently taught by the Schwab reference.

The claim 20 limitations were discussed above (see the claim 3 arguments).

The claim 22 limitations were discussed above (see the claim 11 arguments).

The claim 23 limitations were discussed above (see the claim 3 arguments).

### *Claim Rejections - 35 USC § 103*

9. Claims 8-10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwab as applied to claims 1 and 4 above, and further in view of Nakabayashi et al. (USPN 5,905,866). The arguments as to the relevance of Schwab as applied in the above paragraphs are incorporated herein. With regard to claim 8, Schwab fails to disclose the claimed renewal information preparation means and mail sending means.

However, Nakabayashi, discloses a means for preparing renewal information showing the details of a renewal when the image data or management information stored in the image management server is given an addition or renewed, and mail sending means for sending the renewal information to specific users by electronic mail (Nakabayashi col. 48 lines 38-44). The data-update monitor server disclosed in Nakabayashi is analogous to the renewal information preparation means recited in the claim. It follows that the "results of the update check" disclosed in Nakabayashi is analogous to the "renewal information" recited in the claim. The registration management unit disclosed in Nakabayashi is analogous to the mail sending means recited in the claim.

It would have been obvious to one reasonably skilled in the art at the time of the invention to modify Schwab's image management system to include a renewal information preparation means and a mail sending means as taught by Nakabayashi. Such a modification would have allowed for an image management system in which the user was kept informed about updates to the central server (Nakabayashi col. 48 lines 32-37).

With regard to claim 9, Nakabayashi further discloses that the mail sending means only sends emails to the users who belong to the same group as the user who revised the image data or management information (Nakabayashi col. 48 lines 51-59). The number of users who utilize the same data-update monitor server as disclosed in Nakabayashi is analogous to "users who belong to the same group" as recited in the claim.

With regard to claim 10, Nakabayashi further discloses that the renewal information preparation means further prepares a renewal information list of renewals made for a specific period of time (Nakabayashi col. 48 lines 10-13).

With regard to claim 21, the limitations of the claim were discussed above (see claim 8).

### *Conclusion*

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick L Edwards whose telephone number is (703) 305-6301. The examiner can normally be reached on 8:30am - 5:00pm M-F.

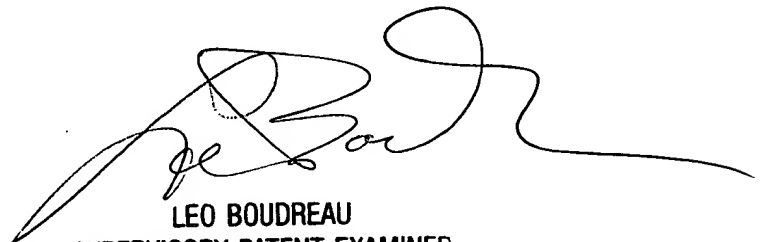
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Boudreau can be reached on (703) 305-4706. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patrick Lynn Edwards

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